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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,105	08/24/2001	Bijan Treister	52637-0029	3365
29989	7590	08/19/2005	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110			WALSH, JOHN B	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/939,105

Applicant(s)

TREISTER ET AL.

Examiner

John B. Walsh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/18/02, 1/28/03, 3/11/03, 11/31/05</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The IDS's filed 3/18/2002, 1/28/2003, 3/11/2003 and 1/31/2005 have been considered and a copy of each has been attached to this correspondence.

### ***Specification***

2. The disclosure is objected to because of the following informalities: Page 1, the related application information needs to be filled in. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-15 are drawn to a method of assigning functions between participants. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The claims are not concrete since, if one of ordinary skill performed the method, they would not be assured repeatable results would occur. The claims are not tangible since the steps of the Method do not require use of hardware to accomplish the steps.

Claims 16-30 are drawn to a computer readable medium. The claims are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 24 , line 10 , the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., CD-ROM) and intangible embodiments (e.g., carrier wave). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the specification, the carrier medium and transmission media would be not statutory but storage media would be statutory.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11, 16, 17, 26 and 31-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite "a failure". It is unclear what the metes and bounds of the claim are since the term "failure" has not been distinctly claimed and it is unclear how the participant has failed.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 4, 5, 8, 9, 11, 13-16, 19, 20, 23, 24, 26, 28-35 and 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-7, 14, 16, 17, 20, 21, 28, 29 and 38 of copending Application No. 10/052,019. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a method for a communications arrangement.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,745,034 to Wang et al.

As concerns claim 1, a method for assigning functions between participants in a communications arrangement comprising a plurality of participants, the method comprising the steps of: assigning, to a first participant from the plurality of participants, one or more functions to be performed by the first participant (serving communication station, column 3, lines 6-10); prior to a failure of the first participant, designating a second participant (targeted communication station, column 4, lines 28-34) from the plurality of participants to perform the one or more functions if any of one or more handoff criteria are satisfied; and in response to any of the one or more handoff criteria being satisfied, assigning the one or more functions to the second participant (column 3, lines 11-23).

As concerns claim 2, the method as recited in claim 1, further comprising unassigning the one or more functions from the first participant (the first serving communication station is unassigned after handoff such that the targeted communication station now becomes the serving communication station).

As concerns claim 3, the method as recited in claim 1, further comprising prior to a failure of the second participant, designating a third participant (column 2, lines 11-13) from the plurality of participants to perform the one or more functions if any of one or more handoff criteria are satisfied (column 5, lines 60-column 6, line 10); and in response to any of the one or more handoff criteria being satisfied, assigning the one or more functions to the third participant, and unassigning the one or more functions from the second participant (the second serving communication station is unassigned after handoff such that the targeted communication station 3<sup>rd</sup> participant, now becomes the serving communication station).

As concerns claim 4, the method as recited in claim 1, wherein the one or more functions include initiating and controlling communications between the plurality of participants (column 5, line 60-column 6, line 4; initiates and controls handoff).

As concerns claims 5 and 20, wherein communications between the participants are made on different frequencies over time (inherent, communication occurs over channels which are a range of frequencies, wherein at particular points in time the frequency of the communications will not be identical).

As concerns claims 6, 7, 21 and 22, wherein each participant from the plurality of participants communicates with other participants during a particular time range (column 5, lines 62-66).

As concerns claims 8 and 23, wherein the communications arrangement is a wireless communications arrangement and the plurality of participants is a plurality of wireless devices (column 1, lines 49-51).

As concerns claims 9 and 24, wherein the one or more handoff criteria include a request (column 4, line 10) from the first participant.

As concerns claims 10 and 25, wherein the one or more handoff criteria include the first participant not communicating within a specified amount of time (column 9, lines 1-8).

As concerns claims 11 and 26, wherein the one or more handoff criteria include a failure of the first participant (column 7, line 63-column 8, line 4).

As concerns claims 12 and 27, wherein the one or more handoff criteria include the first participant being out of range (column 3, lines 24-28; also power levels may drop limiting the range of the participant, meets a threshold inducing a handoff to be performed) of one or more other participants from the plurality of participants.

As concerns claims 13 and 28, wherein: the first participant is a master participant (serving station), the second participant is a slave participant (target station) prior to being assigned to perform the one or more functions, and the second participant is an associate master participant after being designated to perform the one or more functions.

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or more functions if any of the one or more handoff criteria are satisfied (target station becomes serving station after handoff).

As concerns claims 14 and 29, wherein the second participant is designated by the first participant (column 4, lines 28-35).

As concerns claims 15 and 30, the method as recited in claim 1, wherein the second participant is designated by one or more participants from the plurality of participants (column 4, lines 28-35, second or targeted, designated by serving station, which is another participant).

As concerns claim 16, a computer-readable medium carrying one or more sequences of one or more instructions for assigning functions between participants in a communications arrangement, the one or more sequences of one or more instructions including instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of: assigning, to a first participant from the plurality of participants, one or more functions to be performed by the first participant (serving communication station, column 3, lines 6-10); prior to a failure of the first participant, designating a second participant from the plurality of participants to perform the one or more functions if any of one or more handoff criteria are satisfied (targeted communication station, column 4, lines 28-34); and in response to any of the one or more handoff criteria being satisfied, assigning the one or more functions to the second participant (column 3, lines 11-23).

As concerns claim 17, the computer-readable medium as recited in claim 16, further comprising one or more sequences of additional instructions which, when executed by the one or more processors (inherent for the communication system to have processors), cause the one or more processors to unassign (the first serving communication station is unassigned after handoff such that the targeted communication station now becomes the serving communication station) the one or more functions from the first participant.

As concerns claim 18, the computer-readable medium as recited in claim 16, further comprising

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one or more sequences of additional instructions which, when executed by the one or more processors, cause the one or more processors to prior to a failure of the second participant, designating a third participant (column 2, lines 11-13) from the plurality of participants to perform the one or more functions if any of one or more handoff criteria are satisfied; and in response to any of the one or more handoff criteria being satisfied, assigning the one or more functions to the third participant, and unassigning the one or more functions from the second participant (the second serving communication station is unassigned after handoff such that the targeted communication station, 3<sup>rd</sup> participant, now becomes the serving communication station).

As concerns claim 19, the computer-readable medium as recited in claim 16, wherein the one or more functions include initiating and controlling communications between the plurality of participants (column 5, line 60-column 6, line 4, initiates and controls handoff).

As concerns claim 31, a communications device (column 1, lines 49-51) comprising: an interface configured to receive data from a plurality of communications devices (inherent for communication system to have an interface for receiving, i.e. a receiver, column 1, lines 48-60) and to transmit data (transmitter) to other communications devices (column 1, lines 48-60); and a mechanism communicatively coupled to the interface and configured to: perform one or more functions (serving communication station, column 3, lines 6-10), and prior to a failure of the communications device, designate a particular communications device from the plurality of communications devices to perform the one or more functions if any of a set of handover criteria are satisfied (column 3, lines 11-23).

As concerns claim 32, the communications device as recited in claim 31, wherein the one or more functions include initiating and controlling communications between the plurality of communications devices (column 5, line 60-column 6, line 4, initiates and controls handoff).

As concerns claim 33, the communications device as recited in claim 31, wherein the

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communications device is a wireless communications device and the plurality of communications device is a plurality of wireless communications devices (column 1, lines 49-51).

As concerns claim 34, the communications device as recited in claim 31, wherein the one or more handoff criteria include a request (column 4, line 10) from the communications device.

As concerns claim 35, the communications device as recited in claim 31, wherein the one or more handoff criteria include a failure (column 7, line 63-column 8, line 4, failure to meet threshold) of the communications device.

As concerns claim 36, the communications device as recited in claim 31, wherein the one or more handoff criteria include the communications device not communicating within a specified period of time (column 9, lines 1-8).

As concerns claim 37, the communications device as recited in claim 31, wherein the one or more handoff criteria include the communications device being out of range (column 3, lines 24-28, also power level may drop limiting the range of the participant, meets a threshold inducing a handoff to be performed) of one or more of the plurality of communications devices.

As concerns claim 38, the communications device as recited in claim 31, wherein: the communications device is a master participant (serving station), and the particular communications device is an associate master participant (target stations).

### ***Conclusion***

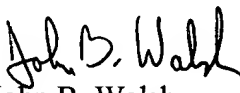
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Wednesday from 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John B. Walsh  
Primary Examiner  
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